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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,895	04/11/2005	Prakash Patel	056258-5096	3203

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EXAMINER

KLEMANSKI, HELENE G

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/530,895

Applicant(s)

PATEL, PRAKASH

Examiner

Helene Klemanski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/11/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Information Disclosure Statement*

1. The references cited in the Search Report dated January 30, 2004 have been considered.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-7 and 9-11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 7-12, 15-20 and 24-29 of copending Application No. 10/531,092. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said copending claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

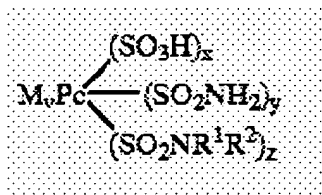
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 2, 3, 7 and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Robertson et al. (US 6,149,722).

Robertson et al. teach a phthalocyanine compound of the formula



wherein M represents a metal such as copper; Pc represents a phthalocyanine nucleus; R<sup>1</sup> represents H; R<sup>2</sup> represents  $-(\text{CH}_2)_n\text{R}^3$ ; n is an integer of from 1 to 30; R<sup>3</sup> is OH; X is from 1.2 to 3.8; y is from 0.1 to 2.7; z is from 0.1 to 2.7 and x, y and z satisfy  $2 \leq x+y+z \leq 4$  and an ink jet ink composition comprising the above phthalocyanine compound and a liquid medium that comprises a mixture of water and an organic solvent or an organic solvent free from water. Robertson et al. further teach a process for printing an image on a substrate such as paper, plastic textile, metal or glass, comprising ejecting the above ink jet ink composition onto the substrate. See col. 1, lines 38-65, col. 2, lines 8-

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10 and lines 25-65, col. 3, lines 5-21, col. 5, lines 38-62, col. 7, lines 40-60, examples 1 and 2, Table I and claims 1-9 and 15-18. The phthalocyanine compound and ink jet ink as taught by Robertson et al. appears to anticipate the present claims.

6. Claims 2-4, 7 and 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Andrievsky et al. (US 6,712,891).

Andrievsky et al. teach an ink jet ink composition comprising water, a humectant and a phthalocyanine colorant of the formula



wherein M represents a metal such as copper; Pc represents a phthalocyanine nucleus; X is H; a is from 0 to 3; b is from 1 to 4; each R independently represents a substituted or unsubstituted C<sub>1-15</sub> alkyl group and each R' independently represents R or H.

Preferably, R is the group CH<sub>2</sub>CH<sub>2</sub>OH. Andrievsky et al. further teach a process for printing an image on a substrate such as paper, plastic textile or glass, comprising ejecting the above ink jet ink composition onto the substrate. See col. 2, lines 41-60, col. 3, lines 4-15, Table 1; colorants 2, 6, 10, 15, 19, 23 and 27, col. 5, lines 14-23, the examples, col. 8, lines 54-55 and claims 1-5 and 7. The ink jet ink composition as taught by Andrievsky et al. appears to anticipate the present claims.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

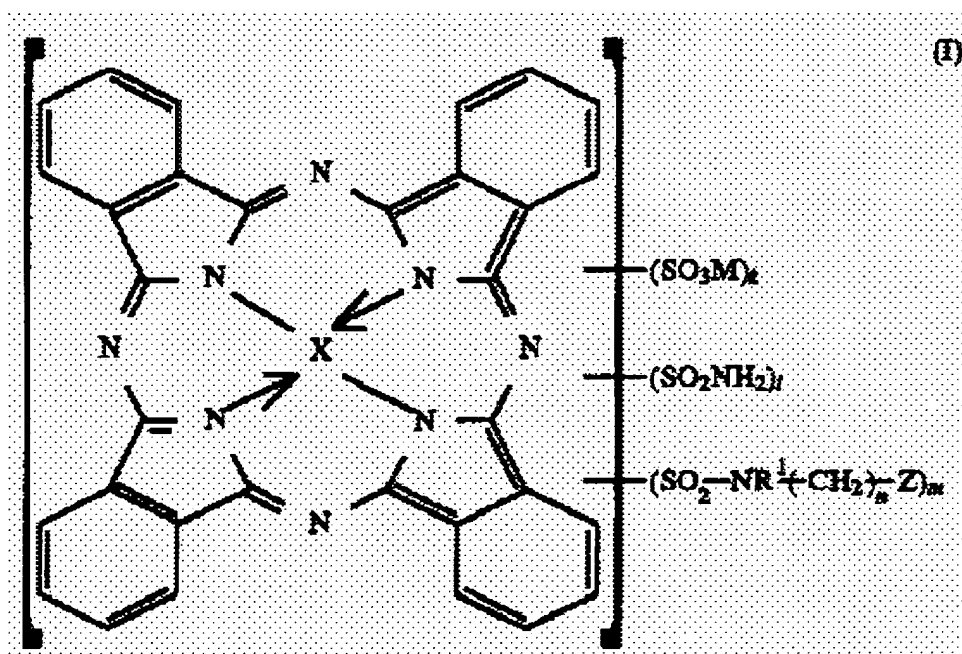
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-4, 7 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanaya et al. (US 5,7804,969).

Kanaya et al. teach a cyan ink jet ink composition comprising a phthalocyanine dye of the formula



wherein X is a metal such as copper; M is H; R<sup>1</sup> is H; Z is OH, n represents an integer of 1 to 15; k and l each independently represent 0 or 1 and m represents an integer of 1 to 4 provided that k, l and m satisfy  $2 \leq k + l + m \leq 4$  and a liquid medium which comprises a mixture of water and a water-soluble organic solvent. Kanaya et al. further teach a process for printing an image on a substrate such as paper comprising ejecting the above ink jet ink composition onto the substrate. See col. 2, lines 10-43, col. 4, lines 13-21, col. 14, lines 6-19 and lines 51-54, Table 1, col. 25, lines 46-58 and claims 1-4.

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Kanaya et al. fail to specifically exemplify a phthalocyanine compound containing a  $\text{SO}_2\text{NHC}_2\text{H}_4\text{OH}$  group as claimed by applicants.

Therefore, it would have been obvious to one having ordinary skill in the art to use the specific phthalocyanine compound containing a  $\text{SO}_2\text{NHC}_2\text{H}_4\text{OH}$  group as claimed by applicants as Kanaya et al. also discloses the use of these phthalocyanine compounds but fails to show an example incorporating them.

### ***Conclusion***

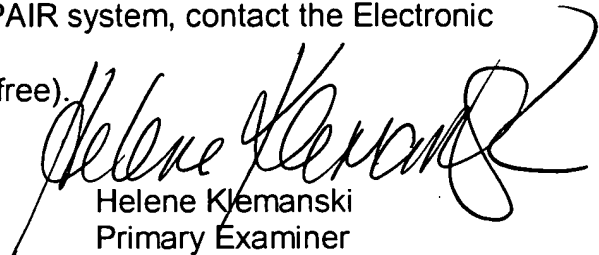
The remaining references listed on forms 892 and 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene Klemanski whose telephone number is (571) 272-1370. The examiner can normally be reached on Monday-Friday 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Helene Klemanski  
Primary Examiner  
Art Unit 1755



HK  
March 13, 2006